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In re Application of: MACHESE, Leonard E.
Application No. 09/613,980
Filed: July 11, 2000
Atty. Docket No. 11590/9-1268
Title: ELECTRONIC SPACE AND METHOD
FOR PROVIDING RESOURCES TO
FACILITATE IDEATION

**DECISION ON PETITION
UNDER 37 C.F.R. § 1.181**

This is a decision on the petition filed 01/02/08 under 37 CFR § 1.181 to invoke Supervisory Authority of the Commissioner and require the Examiner to withdraw the Notice of Non-Compliant Amendment under 37 CFR 1.121 mailed on 12/31/07. This is also a decision on the petition filed under 1.181(a)(1) on 6/05/08, seeking that the Notice of Non-compliance with the requirements under 37 CFR 41.37 mailed 05/30/08 be withdrawn.

These petitions filed 1/2/08 and 6/05/08 are **DISMISSED AS MOOT.**

RELEVANT PROSECUTION HISTORY

10/07/04	Final Rejection in response to amendment filed 06/28/04 is mailed.
02/04/05	Response to final action mailed 10/07/04 is filed.
04/11/05	Advisory Action in response to Reply received 2/04/05 indicating the request for reconsideration mailed thereon will be entered.
5/09/05	Appeal Brief is in response to Final office action mailed 10/7/04.
08/26/05	Non-final office action is filed in response to Brief filed 5/09/05.
01/26/06	Request for Reinstatement of Appeal Brief and second Appeal Brief is filed.
03/13/07	Request for status of application is filed.
09/14/07	Notification of Non-compliance under 37 CFR 41.37 (PTO-462 form) is filed. The notice points out deficiencies with respect to the brief according

to item 4(a) of the form. Additionally comments marked as comment note: Appellant has provided a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawings, if any, by reference characters.

09/28/07 Appellant's Response to the non-compliance mailed 09/14/07 encloses a replacement document supplying the Summary of the Claimed Subject Matter. Appellant also objects to the notice of non-compliance and being improper and untimely because the Brief has been previously submitted on 01/26/06 and there was no indication that the original Brief filed 5/09/05 having virtually identical Summary of the Claimed Invention was non-compliant. Thus, Appellant states that even without the prior review, it should not have taken nearly two years to look at the brief and decide that the brief was non-compliant.

12/31/07 Second Notification of Non-compliance under 37 CFR 41.37 (PTO-462 form) is filed. The notice points out deficiencies with respect to the brief according to item 4(a) of the form. Additionally comments marked as comment note The explanation of the subject matter in independent claims (21, 26 and 32) should be defined in separate sections.

1/02/08 Petition under 1.181(a)(1) is filed, seeking that the Notice of Non-compliance with the requirements under 37 CFR 41.37 mailed 12/31/07 be withdrawn.

3/06/08 Appellant's Response to notice of non-compliance Appeal Brief mailed 12/31/07. The response includes a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, wherein the explanation of the subject matter in independent claims (21, 26 and 32) should be defined in separate sections.

5/30/07 Third Notification of Non-compliance under 37 CFR 41.37 (PTO-462 form) is filed. The notice points out deficiencies under "Others" as: The brief provides an incorrect US patent number (Kirk US Patent No. 6,185,842). It should be corrected as US Patent No. 6,175,842).

06/05/08 Second Petition under 1.181(a)(1) is filed, seeking that the Notice of Non-compliance with the requirements under 37 CFR 41.37 mailed 05/30/08 be withdrawn.

07/29/08 Appellant's Response to notice of non-compliance Appeal Brief mailed 05/30/08. The response includes a replacement paper supplying the Issues

section of the Appeal Brief, to correct typographical error in patent number of the Kirk reference to US Patent No. 6,175,842

REGULATION & PROCEDURES

2274 Appeal Brief: V. REQUIREMENTS FOR THE APPEAL BRIEF

A fee as set forth in 37 CFR 41.20(b)(2) is required when the appeal brief is filed for the first time in a particular reexamination proceeding, 35 U.S.C. 41(a). 37 CFR 41.37 provides that the appellant shall file a brief of the authorities and arguments on which he or she will rely to maintain his or her appeal, including a summary of claimed subject matter which must refer to the specification by page and line number, and to the drawing, if any, by reference characters, and a copy of the claims involved. Only one copy of the appeal brief is required. Where the request for reexamination was filed by a third party requester, a copy of the brief must be served on that third party requester.

1205.02 Appeal Brief Content

(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. While reference to page and line number of the specification requires somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. If appellant does not provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), the Office will notify appellant of the defect in the brief and give appellant a time period within which to file an amended brief. See 37 CFR 41.37(d).

1205.03 Non-Compliant Appeal Brief and Amended Brief

In response to the Notice of Non-Compliant Appeal Brief (37 CFR 41.37) or the Office communication that requires an amended brief, appellant is required to file an amended brief that is either a complete new brief with the required corrections or a replacement section(s) as noted below:

(B) When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief *need not*, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

The examiner should not require a corrected brief for minor non-compliance in an appeal brief (e.g., the brief has a minor error in the title of a section heading). The following are a few other examples where the examiner may accept a brief that has minor non-compliance:

(A) If the evidence appendix and related proceedings appendix are missing, but the record is clear that there is no evidence submitted and no related proceedings listed in the related appeals and interferences section, the examiner may accept the brief and state in the examiner's answer that it is assumed that the appellant meant to include both appendixes with a statement of "NONE "

(B) If appellant only presents arguments for a dependent claim but not for the independent claim in a group of claims that are subject to the same ground of rejection, the examiner may accept the brief and fully explain how the limitations of the independent claim are rejected and address the appellant's arguments regarding the dependent claim in the examiner's answer.

(C) If appellant fails to include a copy of the claims involved in the appeal in the claims appendix section of the brief, the examiner may either: (1) provide a copy of the claims in the examiner's answer, or (2) object to the appeal brief and require an amended brief.

DECISION

The record has been reviewed and in view of: (i) Appellant's response to the non-compliance mailed 09/14/07 which enclosed a replacement document supplying the Summary of the Claimed Subject Matter; (ii) Appellant's Response to notice of non-compliance Appeal Brief mailed 12/31/07 which enclosed a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, wherein the explanation of the subject matter in independent claims (21, 26 and 32) should be defined in separate sections; and (iii) Appellant's Response to notice of non-compliance Appeal Brief mailed 05/30/08, which enclosed a replacement paper supplying the Issues section of the Appeal Brief, to correct typographical error in patent number of the Kirk reference to US Patent No. 6,175,842, the Appeal Brief filed on 07/29/08 **fully complies** with 37 CFR § 41.37 and is ready for examiner's consideration.

It is noted that the examiner should not require a corrected brief for minor non-compliance in an appeal brief (e.g., the brief has a minor error in the title of a section heading) (see MPEP §1205.03).

For the above stated reasons, the petition filed 01/02/08 under 37 CFR § 1.181 to invoke Supervisory Authority of the Commissioner and require the Examiner to withdraw the Notice of Non-Compliant Amendment under 37 CFR 1.121 mailed on 12/31/07 is **DISMISSED as moot**.

For the above stated reasons, the petition filed under 1.181(a)(1) on 6/05/08, seeking that the Notice of Non-compliance with the requirements under 37 CFR 41.37 mailed 05/30/08 be withdrawn is **DISMISSED as moot**.

The application has been forwarded to examiner of record to consider the Appeal Brief filed on 7/29/08 and issue an appropriate action expeditiously.

Any inquiry regarding this decision should be directed to the undersigned whose telephone number is (571) 272-3902. If attempts to reach the undersigned by telephone are unsuccessful, Kim Huynh, Quality Assurance Specialist, can be reached at (571) 272-4147.

/bp/

/Beatriz Prieto/

Beatriz Prieto, Quality Assurance Specialist
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